



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,004	01/02/2002	Daniel R. Baum	Shutterfly 04C001	8059
31688	7590	12/17/2003	EXAMINER	
			GARG, YOGESH C	
		ART UNIT		PAPER NUMBER
		3625		

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/038,004	BAUM, DANIEL R.
<b>Examiner</b>	<b>Art Unit</b>	
Yogesh C Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/2003 has been entered.

***Response to Amendment***

2. Amendment C, paper # 13, received along with R.C.E., on 10/01/2003 is acknowledged and entered. Claims 1, 14, 16, 17, and 21 have been amended. Currently claims 1-21 are pending for examination.

***Response to Arguments***

3. Applicant's arguments with respect to amended claims 1-21 have been fully considered but are moot in view of the new ground(s) of rejection, i.e. references Lockhart et al. ( US Pub.No: 2002/0103697 A1), Johnson (US Patent 6,052,670), and Hartman et al. (US Patent 5,960,411) necessitated due to the amendments in claims 1, 14, 16, 17, and 21.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-4, 7-12, 14, 16-17, and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3-5, 8, 9, 10, 15, 35, 38, and 80 of co-pending Application No. 09/436,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because for reasons as given below:

Method claims 1, 16, and 21 of instant application, differ from the method claim 1 of co-pending application No. 09/436,704 that they recite the limitation "card order" in place of "order for image prints" and further specify that the images are uploaded directly by the user. The limitation "order for card" corresponds to the order for image prints only and using a different name "card" in place of "image print" does not patentably distinct each other. Further, adding of the limitation, "images directly uploaded by a user" is an obvious variation of the limitation receiving an order specifying a set of images associated with the recipient as those image have to be supplied by the user and uploading is one of the possible ways. The method claim 16 of the instant application also recites the additional limitation of receiving the order at a "host system" from a "client system" which again are obvious extension of the claim 1 of the co-pending

Art Unit: 3625

application specifying receiving an order and the order, when being sent via a network, has to be received at a system and that system can be called a host system and the user while sending the order via a network would also use a software browser and the same could be a client system.

Similarly, system claim 14 of instant application is an obvious variation of system claim 80 of the co-pending application No. 09/436,704.

Limitations recited in the dependencies of claim 1, i.e., claims , 3, 4, 7, 8, 9, 10, 11, 12 of instant application are identical to the ones recited in the dependencies of claim 1, i.e. , claims 2, 3-5, 9, 8, 10, 15, 35, and 38 respectively of the co-pending application No. 09/436,704 .

Regarding claim 17 of the instant application, its limitations are already covered by the limitations recited in claims 1 and 4 of the instant application except that it also specifies receiving names and addresses of the recipients to whom the order is to be distributed. Therefore, claim 17 of the instant application is also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of the co-pending application. As regards the additional limitation of receiving names and addresses, it is obvious variation of the existing limitation of distribution of the cards I claim 1 of the instant application. In order to distribute the cards to recipients it will be obvious to receive their names and addresses.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim objections***

5. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The limitation recited in claim, "the

Art Unit: 3625

card order comprises a single transaction sequence" is already recited in the previous claim 1 on which the claim 11 depends and therefore fails to further limit claim 1. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.1. Claims 1- 3, 5-12, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Lockhart et al. ( US Pub.No: 2002/0103697 A1), hereinafter, referred to as Lockhart and in view of Johnson (US Patent 6,052,670) and further in view of Hartman et al. (US Patent 5,960,411), hereinafter , referred to as Hartman.

**Regarding claim 1,** Shiota teaches a computer implemented method of distributing cards to a plurality of recipients (see at least abstract), the method comprising:

receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more uploaded images associated with that recipient (col.10, line 33-col.11, line 21 ".....*The WWW application server 36 receives the order file 20 uploaded by the user, selects the laboratory server 8 which is best-suited for processing the order, and transfers the order file 20 as it is or after adding necessary instruction information thereto.....*" . Note, Here, Shiota teaches that the center server receives an order from the customer (personal computer 6) which includes uploaded image data for the prints ordered for recipients. The orders include postcards

Art Unit: 3625

(col.3, lines 31-35, “.....*the processing number specifying what has been ordered (such as an extra print or a postcard generation).....*”) and picture postcards (col.4, lines 28-32, “.....*generation of a picture postcard as described above,.....*”) which correspond to a card order in the application. Col.11, line 38-col.12, line 24, “.....*an extra print of a picture a is ordered for the customer while a picture b is for the friend,.....*” discloses that there are plurality of recipients (customer and his/her friend).

Also see Fig.1 (6-PC correspond to plurality of recipients);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one uploaded image from the recipient's image set and distributing the printed cards having the recipients' uploaded images to their respective associated recipients (col.11, lines 38-col.12, line 24. Customer and his friend are the plurality of recipients and prints (which could be photograph/postcards/picture postcards as disclosed in col.3, lines 31-35 and col.4, lines 28-32, “.....*The printing service*” in this specification means not only services such as outputting an extra print or generation of a picture postcard as described above, but also all accompanying services carried out before the picture print reaches a customer.....”) with uploaded images are distributed to customer and to the customer's friend).

Shiota does not expressly disclose that the images are directly loaded by a user when generating the card. However, in the field of same endeavor, that is generating a postcard online including image and text to be delivered to recipients, Lockhart discloses uploading of images directly by a user to be included in the said postcard and page 4 paragraph 062, “.....,*the user is allowed to upload an image using a web interface (e.g., region 302 of the exemplary web page shown in Fig. 3). That is, the user clicks on a "Browse" button 306 to select a graphical image (e.g., a JPG image) that resides on the user system hard drive or network neighborhood. The user then initiates uploading the image (button 308), and the image data is*

*transferred to mail service computer 110. Such methods for uploading files are known in the art.*  
").

In view of Lockhart, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota to incorporate the Lockhart's teachings of uploading images directly by the user because when the desired images are not already available at the image server 15 in Shiota, it will allow the users to upload images directly from another source as explicitly suggested in Lockhart (see at least page 4, paragraphs 0050-0053, "*..Where appropriate (i.e., when the image does not already reside on the mail service computer) the selected image is transferred to mail service computer in step 208 and suitably displayed to the user, e.g., by launching a web browser.... . In general, in the case where the user wishes to create a post card incorporating one or more graphics based on an online ....., a postcard showcase, or a photo collection, the appropriate graphical elements are stored at any convenient site accessible to the user over network 106. For example, the images may be located in a database 111 or other storage medium associated with mail service computer 110. .... " ).*

Shiota in view of Lockhart as applied to claim 1 does not expressly disclose receiving a single order for the plurality of recipients. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Johnson discloses receiving a single order for the plurality of recipients (see at least FIG.16 and col.22, lines 60-62, "*Customer has a "contains by value" relationship with the Order class. In other words, each customer may have one or more orders, and each order may have multiple ship addresses and multiple order items*". Note: each order having multiple ship addresses corresponds to receiving order for plurality of recipients in a single transaction). In view of Johnson, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have

Art Unit: 3625

modified Shiota in view of Lockhart as applied to claim 1 to incorporate the Johnson's teachings of receiving a single order for a plurality of recipients because it will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients.

Shiota in view of Lockhart further in view of Johnson as applied to claim 1 does not expressly suggest receiving order in a single transaction sequence. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online , Hartman discloses receiving an order in a single transaction sequence (see at least col.2, lines 50-57, "*An embodiment of the present invention provides a method and system for ordering an item from a client system.....The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item.....*"). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota in view of Lockhart and further in view of Johnson as applied to claim 1 to incorporate the Hartman's teachings of receiving an order in a single transaction sequence because the single transaction sequence ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

**Regarding claim 2,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota further shows that the card is one or more of a greeting card, a post card, and a playing card (see at least col.4, lines 28-32, " "*The printing service*" in this specification means not only services

*such as outputting an extra print or generation of a picture postcard as described above, but also all accompanying services carried out before the picture print reaches a customer.* ". Note: Since the claim limitation specifies one or more of a greeting card, a post card..., Shiota by disclosing that the card is a picture postcard satisfies the claimed limitation).

**Regarding claim 3,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota further suggests that the images in a first recipient's image set differ from the images in a second recipient's image set (col.11, lines 38-col.12, line 24, "*..... an extra print of a picture a is ordered for the customer while a picture b is for the friend,.....*". Note: picture a is for the customer and picture b is for the friend. Pictures a and b are different pictures which are ordered for two different recipients, that is the customer and his friend).

**Regarding claim 5,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that the images are uploaded by a user from a digital camera (see at least col. 2, lines 34-42, "*.....a picture image obtained from a memory or the like of a digital camera....*").

**Regarding claim 6,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that the images are uploaded by a user to a printing service (see at least , Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10),

**Regarding claim 7,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that receiving, printing and distributing is dispersed among two or more different entities (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10. Note: laboratory server and center server are two or different entities).

**Regarding claim 8,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that the steps of receiving, printing and distributing is performed by a single entity (col.1, lines 29-38, “*..However, it is preferable to have only one wholesale lab ....data management* “). Note: To have only one wholesale lab to manage all data concerning receiving the orders corresponds to having a single entity to perform all the steps of receiving, printing and distributing.).

**Regarding claim 9,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that receiving a card order is performed by an enterprise providing a web front-end (See. Figs.1 and 6.) “Center server 12 “ which is a www application server and receives the orders from the customer’s personal computers corresponds to an enterprise providing a web front-end. Also see col.10, lines 30-41).

**Regarding claim10,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also

teaches that prior to printing, dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient (col.11, lines 38-col.12, line 24. Note: picture a is for the customer and picture b is for the friend. Pictures a and b could be different which are ordered for two different recipients, that is the customer and his friend and in order to process them they will inherently be sub divided into separate sub-cards belonging to the customer and friend respectively.)..

**Regarding claim 11,** the limitation that the card order comprises a single transaction sequence is already covered and analyzed in claim 1.

**Regarding claim 12,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients and receiving an order in a single transaction sequence. Shiota/Lockhart/Johnson/Hartman as applied to claim 1 does not suggest that the single transaction sequence is terminated by a click of a "card order" button. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online , Hartman discloses that the single transaction sequence is terminated by a click of a "card order" button. (see at least col.2, lines 50-57, "*An embodiment of the present invention provides a method and system for ordering an item from a client system.....The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item....*". Note: In Hartman, a **single action such as clicking a mouse button** corresponds to a click of "card order" button as claimed.). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota/Lockhart/Johnson/Hartman as applied

Art Unit: 3625

to claim 1 to incorporate the Hartman's teachings of terminating the single transaction sequence by a click of a "card order" button because such ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

**Regarding system claim 14,** all the functional limitations are already covered in the method steps of claims 1 and 9 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman. As regards, the structural elements, see Shiota, ( at least FIG.6, where "12" Central server, which receives the order from the client system, corresponds to the front-end computer sub-system and the Laboratory server "8" corresponds to the distribution sub-system. ).

**Regarding claim 15,** Shiota/Lockhart/Johnson/Hartman as applied to claim 14 discloses a computer-implemented system of distributing cards to a plurality of recipients. Further, the recited limitation in claim 15 is already covered and analyzed in claim 2 above and is therefore rejected on the basis of same rational as unpatentable over Shiota/Lockhart/Johnson/Hartman.

**Regarding method claim 16,** all the limitations are already covered in the method steps of claims 1 and 9 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman. As regards the host system and client system, see Shiota, ( at least FIG.6, where "12" Central server, which receives the order from the client system, corresponds to the host system and the WWW Browser on customer's personal computer "6" corresponds to the client-system. ).

**Regarding method claim 17,** all the limitations are already covered in the method steps of claims 1 and 4 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman. As regards the limitation of obtaining address information including names and addresses of one or more recipients, they are inherently needed to distribute the cards to the recipients.

**Regarding method claims 18 and 19,** all the recited limitations are already covered in the method steps of claims 5 and 6 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman.

**Regarding claim 20,** Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients and the images are directly uploaded by the user. Shiota/Lockhart/Johnson/Hartman as applied to claim 1 does not suggest that the images are uploaded by a user from a data storage device. However, in the field of same endeavor, that is generating a postcard online including image and text to be delivered to recipients, Lockhart discloses uploading of images directly by a user from a data storage device (see at least page 4 paragraph 0053, “ . . . . In general, in the case where the user wishes to create a post card incorporating one or more graphics based on an online . . . . , a postcard showcase, or a photo collection, the appropriate graphical elements are stored at any convenient site accessible to the user over network 106. For example, the images may be located in a database 111 or other storage medium associated with mail service computer 110. Alternatively, the graphics may be distributed over a number of databases or vendors accessible over network 106 . . . . ”). In view of Lockhart, it would have been obvious to a

Art Unit: 3625

person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota/Lockhart/Johnson/Hartman as applied to claim 1 above to incorporate the Lockhart's teachings of uploading images directly by the user from a data storage device because when the desired images are not already available at the image server 15 in Shiota, it will allow the users to upload images directly from another source/database as explicitly suggested in Lockhart (see at least page 4 paragraph 0050, "*.....Where appropriate (i.e., when the image does not already reside on the mail service computer) the selected image is transferred to mail service computer in step 208 and suitably displayed to the user, e.g., by launching a web browser.... ". ).*

**Regarding claim 21**, all the method steps of the claim, except one, are already covered in the method steps of claim 1 above. The step, that the order is received from the orderer and that at least one of the specified recipients is different from the orderer is not covered in claim 1 above. However, Shiota does teach this limitation that the order is received from the orderer and that at least one of the specified recipients is different from the orderer (see at least col.11, lines 54-61, "*After the customer returns, he/she accesses the center server 12 from the personal computer 6 at home and orders extra prints of these pictures (105). At this time, ....an extra print of a picture a is ordered for the customer while a picture b is for the friend, .....". Note: Here, in Shiota the orderer is a customer and one of the recipients is a friend of a customer who is different from the orderer.). Therefore, claim 17 is also rejected as being unpatentable over Shiota in view of Lockhart further in view of Johnson and further in view of Hartman.*

6.2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota/Lockhart/Johnson/Hartman and further in view of Tackbary et al. (US Patent 6,092,054).

Regarding claim 4, Shiota/Lockhart/Johnson/Hartman teaches a computer-implemented method of distributing cards to a plurality of recipients, as disclosed and analyzed in claim 1 above. Shiota also teaches that print parameters of a first recipient's cards differ from printing parameters of a second recipient's cards (see at least col. Col.11, lines 54-61, "(see at least col.11, lines 54-61, "*After the customer returns, he/she accesses the center server 12 from the personal computer 6 at home and orders extra prints of these pictures (105). At this time, ....an extra print of a picture a is ordered for the customer while a picture b is for the friend, .....*". Note: Here, in Shiota the prints ordered for the orderer is a and for the 2<sup>nd</sup> recipient, who is a friend, is b. The prints a and b are different and hence the printing matter of a and b will also be different.). Shiota further shows that the print parameters include one or more of print size, number of copies, print finish (col.3, lines 31-35, " *The order information*" specifically means, for example, *the processing number specifying what has been ordered (such as an extra print or a postcard generation), the image number identifying a picture, the size of the print, and the number of the print...*". Also see col.8, lines 31-36. Note: " requirement of extra prints" correspond to the number of copies as claimed. Since the claim limitation specifies one or more of print size, number of copies, ..., Shiota by disclosing that the card order information includes print size, number of extra prints satisfies the claimed limitation .),

Shiota/Lockhart/Johnson/Hartman as applied to claim 1 does not disclose that the print parameters include a textual message. However, in the field of same endeavor, Tackbary teaches printing a greeting card and a playing card with textual message which are grouped under "social expression cards " (at least see, col.1, line 19-col.2, line 46, " ....*The invention relates... ordering, and delivering social expression cards.....upon receiving an order, to select designated cards....print the buyer's messages on the cards, and send the cards to the buyer or the recipients*" . ). In view of Tackbary, it would have been obvious to a person of an

Art Unit: 3625

ordinary skill in the art at the time of the invention to modify Shiota/Lockhart/Johnson/Hartman to include the feature of printing and distributing greeting card, playing card or other social expression cards such as picture postcard with textual message. Doing so would allow the customer in Shiota to modify the picture postcards to social expression cards, like greeting cards or playing cards, with textual messages and send them on occasions like birthdays/anniversary, etc. and thereby eliminating the need to spend time and effort in buying them from another source.

6.3. Claim 13 is rejected under 35 U.S.C. 103(a) as being obvious over Shiota/Lockhart/Johnson/Hartman in view of an Official Notice.

**Regarding claim 13,** Shiota/Lockhart/Johnson/Hartman teaches a computer-implemented method of distributing cards to a plurality of recipients, as disclosed and analyzed in claim 1 above. Shiota further discloses that customer, while transmitting order information to the central server 12, also transmits information on "payment method" (see at least (Fig.2) and col.8, lines 31-46). Shiota does not expressly disclose that the payment method is one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. However, Official Notice is taken of both the concept and benefits of making payment online by one or more of the old and well-known methods such as credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon for the obvious reasons of convenience to both the customers and merchants and closing the purchase or sale transaction. In view of the Official Notice, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use one or more of the very old and well-known payment methods such as credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. Doing so makes it

convenient for both the customers and merchants to close the purchase or sale transaction without waiting to pay by cash.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

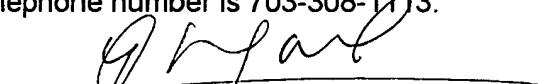
(i) US Patent 5,666,215 to Fredlund et al. teaches an interactive system and a method for remote ordering and reordering of photographic prints/images (see at least col.4, line 37-col.7, line 17. The prior art disclosed in Fredlund et al. and in combination with Lockhart and Johnson could also be used to render the claims 1-21 as unpatentable under U.S.C. 35 103 (a).

(ii) EP 0889660 A2 to Nishino et al. teaches a wireless method and system to transmit and receive data files from a user's terminal to a web server (see abstract at least).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Yogesh C Garg  
Examiner  
Art Unit 3625

Application/Control Number: 10/038,004

Art Unit: 3625

Page 18

YCG

December 13, 2003